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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,482	03/31/2000	Stephen J. Brown	HERO-1-1078	1136
25315	7590	10/01/2004	EXAMINER	
BLACK LOWE & GRAHAM, PLLC			THOMPSON, MARC D	
701 FIFTH AVENUE			ART UNIT	PAPER NUMBER
SUITE 4800			2144	3
SEATTLE, WA 98104			DATE MAILED: 10/01/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/540,482	BROWN, STEPHEN J.
	<b>Examiner</b>	<b>Art Unit</b>
	Marc D. Thompson	2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 April 2004.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-64 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |                                                                                               |                                                                             |
|-----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.
2. Applicant's submission, Amendment C, Paper #12, received 4/16/2004, has been entered into record.
3. Claims 1-64 are now pending.

### ***Priority***

4. This application is a continuation of Application 09/394,219, now U.S. Patent Number 6,375,469, which is a continuation of Application 08/814,293, now U.S. Patent Number 5,951,300.
5. The effective filing date for the subject matter defined in the pending claims in this application is 3/10/1997.

### ***Drawings***

6. The examiner contends the drawings submitted on 11/17/2003 are acceptable for examination purposes.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-64 are rejected under 35 U.S.C. §103(a) as being unpatentable over Logan et al. (U.S. Patent Number 5,761,683), hereinafter referred to as Logan, in view of van Hoff (U.S. Patent Number 5,822,539), hereinafter referred to as van Hoff.

9. Logan disclosed the examination of HTML documents and the selective substitution of information within the document, primarily but not limited to URL hyperlinks. See, *inter alia*, Abstract. Logan disclosed basic string replacement in HTML document(s) providing the invention substantially as claimed. See, *inter alia*, Figures 2-4, and especially, Figure 5. Also see, the invention operation examples provided in Columns 8-9 for clear evidence that HTML document portion substitution was effected, and done so with a significant level of arbitrary behavior. In reality, plain text HTML is just that, plain text, and any and all plain text processing available at the time of invention was suitable to process the HTML document. It is also asserted that all known document processing algorithms would have been recognized as obvious to one with ordinary skill in the art at the time of invention if the end result was within scope of the cited and applied teachings. Likewise, various types of end-user equipment (e.g., STBs, home computers, handheld devices, proxy processes, etc.), effecting rendering and/or document processing are obvious variations of terminal units known to have been capable of performing this trivial concept. In short, the use of arbitrary network terminals to modify identified portions of HTML documents would have been realized by the teachings of Logan, including the minimal deletion or omission of specifically predetermined text strings. The claimed "swapping mechanism" performing "swap order(s)" was also provided explicitly by Logan, *inter alia*, in

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Column 2, Lines 25-28, where functionality of parsing, selective document portion substitution, and display output rendering manipulation was described. Lastly, Logan further disclosed direct suggestion of enabling annotation of the original document (inter alia, Column 2, Lines 42-47), and the suppression of information and functionality in a network document (inter alia, Column 2, Lines 11-17, and Column 8, Lines 3-4). This would have motivated one of ordinary skill in the art at the time the invention was made to search specifically for teachings relating directly to HTML annotation in accordance with the Logan description.

10. In the same art of HTML manipulation, examination, and modification, van Hoff specifically disclosed prior art proxy processes acting to omit undesired information within HTML documents (Column 2, Lines 16-29), and the merging of HTML plain text segments into HTML documents for subsequent rendering. See, inter alia, Column 5, Lines 41-45. The provision for document characteristics and user profile(s) for proxy document modification was also disclosed, inter alia, in Column 6, Lines 5-19. Van Hoff specifically provided simplistic terms for the operation of the system parsing and comparing the characters, words, phrases, with arbitrary match patterns in an annotation directory, providing a straight-forward document modification operation. See, inter alia, Column 7, Lines 1-5, and Column 8, Lines 4-29, and Figure 2. Atomic procedural granularity was also specifically provided, inter alia, in Column 9, Lines 34-39.

11. The modification of the Logan system with the teachings of van Hoff would have been obvious to one of ordinary skill in the art at the time of invention in order to effect the annotation functionality specifically mentioned in Logan (Column 2, Lines 42-47) with this precise functionality set forth in van Hoff (Column 4, Lines 39-46).

12. Claims 1-64 are rejected.

*Response to Arguments*

13. No arguments are presented by Applicant in the response, Paper #12, received on 4/16/2004, and thus, cannot be considered persuasive. Further, it is unclear why the claims previously presented are being modified, and why presentation of claims not previously presented, especially in the number of claims newly added, are now being sought. The extreme breadth of a number of the independent claims is stunning, and other rejection(s) not specifically made may be appropriate in regard to many of these overly broad, skeletal claims. Clarification of the intended scope of the claims along with specific portions of the specification being relied upon for "means or step plus function" language utilized in some of the claims to impart the structure being claimed is suggested. Reconsideration and modification of the breadth of these newly presented claims, in light of the previously cited and applied art(s) and the currently cited/applied art, is strongly advised.

14. The lack of Applicant's arguments may fail to comply with 37 CFR 1.111(b) since they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references of record. Additionally, Applicant's arguments may fail to comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made in previous actions for this, and the parent case. Further, they do not show how the amendments avoid such references or objections.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 703-308-6750. The examiner can normally be reached on Monday-Friday, 9am-4pm. Note: The Examiner expects to move to the new PTO site in Carlyle in the next few months, and contact information will change at that time. If not available at the above number, The Examiner can be reached at 571-272-3932.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, Jr. can be reached on 703-308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARC D. THOMPSON  
MARC THOMPSON  
PRIMARY EXAMINER

Marc D. Thompson  
Primary Examiner  
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